

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUN 27 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TRUNG T. DOAN

Appeal No. 2005-1352
Application 09/652,713

ON BRIEF

Before OWENS, JEFFREY T. SMITH, and PAWLIKOWSKI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 36 and 37, which are all of the claims pending in the application.

THE INVENTION

The appellant claims a device for removing the edge bead that forms when a wafer is spin-coated with a chemical. The claimed device dispenses a solvent near the edge bead and uses suction to remove the dissolved edge bead and excess solvent.

Claim 36 is illustrative:

36. A device for an edge bead, comprising:

a dispenser configured to release a chemical toward said edge bead; and

a splash controller around said dispenser, physically unattached from said edge bead, and configured to draw said chemical toward said splash controller, wherein said splash controller is configured to generate a gas pressure around said edge bead that is lower than an ambient gas pressure, and wherein said splash controller is configured to physically intercept said chemical.

THE REFERENCE

Hurtig 5,289,222 Feb. 22, 1994

THE REJECTION

Claims 36 and 37 stand rejected under 35 U.S.C. § 112, ¶2 as being indefinite.

OPINION

We reverse the aforementioned rejection and remand.

This case previously was before the board (appeal no. 2002-2158). In that appeal, appellant appealed the examiner's rejection of claims 36 and 37 as being anticipated by Hurtig under 35 U.S.C. § 102(b). The board did not reach the § 102(b)

issue because the board found the metes and bounds of the claims to be not determinable.

The board's reasoning:

The common applicable definition of 'configured' is 'shaped,' of 'draw' is 'to cause to move toward,' and of 'generate' is 'to bring into existence.' Thus, claim 36 requires that the splash controller be so shaped as to (1) cause the chemical to move toward it and (2) cause a gas pressure lower than an ambient gas pressure to be brought into existence around the edge of the bead (board's decision, page 4).

[F]rom our prospective, one of ordinary skill in the art would not be advised by the specification of what structure of the splash controller is 'configured to draw' the chemical toward it and 'configured to generate' a gas pressure that is lower than ambient..., inasmuch as it would appear that it is the suction applied through the splash controller and not the configuration of the splash controller that accomplishes these tasks (board's decision, pages 5-6)

The board rejected claims 36 and 37 on new grounds as being indefinite under 35 U.S.C. § 112, ¶2.

Appellant submitted a showings of fact pursuant to 37 C.F.R. 1.196(b) (1) to avoid a termination of proceedings. Appellant's showings of fact included dictionary definitions of "configure" and excerpts from patents that disclose suction as being a function of the design or the arrangement of a device. Appellant's showings of fact cited the dictionary definition of "configure" to be: "[t]o design, arrange, set up, or shape..." THE AMERICAN HERITAGE ELECTRONIC DICTIONARY (1992). Appellant argued that

"configured" meant "to set up for operation" and that "one of ordinary skill in the art would be aware that suction is a function of design, arrangement, set up, or shape (i.e. configuration) of a relevant device, as demonstrated by the patents cited [in the showings of fact]" (brief, page 8).

The examiner considered appellant's showings of fact and found it to be unpersuasive because the showings of fact did not contribute anything new (office action, 12/28/03). The examiner let the board's rejection under § 112, ¶2 stand and appellant now appeals the examiner's decision.

Appellant in this appeal argues that the claims meet the definiteness requirement of 35 U.S.C. § 112, ¶2. Appellant makes the same arguments appellant made previously in the showings of fact.

"The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (citations omitted).

The specification in pertinent part states:

In one aspect of this system, an apparatus for removing the edge bead includes a mechanism for dispensing a solvent selectively onto the edge of the wafer, and a mechanism surrounding the dispensing mechanism for vacuuming excess solvent and dissolved coating material from the edge of the wafer (specification, page 2 lines 18-21).

The specification also points out that it is the application of suction to the area immediately surrounding the edge bead that accomplishes the goal of reducing spillage of the solvent onto other areas of the wafer (specification, page 5).

Appellant's figure 1 shows that dispensing nozzle 16 is surrounded by vacuum port 18 (splash controller). The specification indicates that vacuum port 18 is coupled with a mechanism that is a source of suction (specification, page 3 lines 17-20).

We conclude that the limitations "configured to draw" and "configured to generate" are definite because when "configure" is given its broadest meaning in light of the dictionary definition provided by appellant and the specification, one of ordinary skill would reasonably interpret the scope of limitations to refer to the way in which the splash controller is situated with respect to the dispenser (i.e., around it) and understand that the splash controller will be coupled with a source of suction.

For the above reasons, we reverse the rejection under 35 U.S.C. § 112, ¶2.

REMAND

We remand the application to the examiner for the examiner and appellant to address the rejection under 35 U.S.C. § 102(b) which was not reached by the board in the previous appeal.

DECISION

The rejection under 35 U.S.C. § 112, ¶2 of claims 36 and 37 is reversed. The application is remanded to the examiner.

REVERSED AND REMANDED

Appeal No. 2005-13
Application No. 09/652,713

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